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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,482	12/07/2006	Ulrich Gerber	125198	7245
27049	7590	03/11/2010	EXAMINER	
OLIFF & BERRIDGE, PLC			ADMASU, ATNAF S	
P.O. BOX 320850				
ALEXANDRIA, VA 22320-4850				
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			03/11/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27049@oliff.com  
jarmstrong@oliff.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/552,482	GERBER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ATNAF ADMASU	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

1. Claims 1, 3-16 and 18-21 are pending as amended on 28 December 2009; claim 21 is new and claims 2 and 17 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.

### ***Response to Amendment and Arguments***

3. Applicant's terminal disclaimer, filed 28 December 2009, has been fully considered and is proper.

The rejection of claims 1-6 and 9-16 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/552,481 has been withdrawn.

4. Applicant's amendment to the Abstract, specifically including the chemical structure of the phenolic compound of Formula I in the Abstract has been fully considered and overcomes the following:

Objection to the Abstract.

5. Applicant's amendment to the specification, specifically correcting the ratio of the viscosities of 2,5 to 2.5 has been fully considered and overcomes the following:

Objection to the specification.

6. Applicant's cancellation of claim 17, filed 28 December 2009, has rendered the following moot:

The rejection of claim 17 under 35 USC 112, second paragraph, has been withdrawn.

The rejection of claim 17 under 35 USC 101 has been withdrawn.

7. Applicant's argument, specifically that US Patent 5,688,905 (Walker hereinafter) generally discloses Mannich bases that are condensates of phenol or an alkyl phenol but is completely silent on using bases that are unsubstituted at the ortho and para positions has been fully considered and are persuasive.

The rejection of claims 1-20 under 35 USC 102(b) as being anticipated by Walker has been withdrawn.

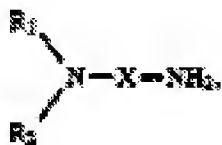
### ***Claim Rejections - 35 USC § 102***

8. Claims 1, 3-16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over US Patent 5,688,876 (Ando hereinafter).

Ando teaches a curable epoxy resin composition comprising (i) an epoxy resin and (II) a specific Mannich base (Abstract). The Mannich base is prepared by reacting an aromatic compound having at least one phenolic hydroxyl group in the molecule with

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a carbonyl compound having at least one carbonyl group in the molecule and an amino compound represented by the formula:



wherein R1 and R2 each represents an alkyl group having 1 to 5 carbon atoms, and X represents an alkylene group having 1 to 5 carbon atoms (column 2, lines 10-24).

Ando further teaches that the aromatic compound has at least one unsubstituted reactive site, i.e., at least one hydrogen atom, on the aromatic ring, and preferable examples of such compounds include not only phenol and alkyl phenols (column 12, 14-19). Specific examples of the alkyl phenols include ortho-, meta- and para-cresols and xlenol (column 12, lines 20-22). Among the monohydric aromatic compounds, phenol and cresol are particularly preferable in practical use (column 12, lines 26-27).

Ando further discloses since an aromatic compound generally has a reactive site on the aromatic ring at a position ortho or para to the phenolic hydroxyl group, it is preferable to use an aromatic compound, particularly a phenol, having at least one unsubstituted site, i.e., hydrogen atom, at a position(s) ortho and/or para to the hydroxyl group(s). The reaction product, i.e., the Mannich base obtained by the use of such an aromatic compound is excellent in compatibility with the epoxy resin (column 12, lines 43-52).

Ando further teaches the carbonyl compound having at least one carbonyl group in the molecule is a compound having at least one -CHO or at least one



in the molecule (column 12, lines 52-60). Examples of the carbonyl compounds include formaldehyde (column 12, lines 61-62).

Ando further disclose Examples of the amino compounds include dimethylaminopropylamine, diethylaminopropylamine, dibutylaminopropylamine and dimethylaminoethylamine. Among them, dimethylaminopropylamine and diethylaminopropylamine are particularly preferable in practical use. These amino compounds can be used not only each alone but also as a mixture of two or more of them (column 13, lines 7-13).

In a typical example, Ando discloses that diethylaminopropylamine and m-cresol were fed into a flask and formaldehyde was drop wise added to the resulting mixture which eventually produced a Mannich base which had a viscosity of 28 poise at 25°C (column 15, lines 19-39). M-cresol reads on Formula I where  $R^1=H$  as instantly claimed.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ATNAF ADMASU whose telephone number is (571)270-5465. The examiner can normally be reached on M-F 8:00-5:30, Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ASA/

/Timothy J. Kugel/  
Primary Examiner, Art Unit 1796